

REMARKS

Claims 1-20 are pending in the application and stand rejected.

Objections to the claims

Claims 3, 4, 16, 17 and 20 stand objected to for containing various informalities. In the interest of passing this case to issue, Applicant has amended these claims in accordance with the Examiner's suggestions and submits that these objections are now moot.

Rejection under 35 U.S.C §112

Claims 5, 10, 15, 17 and 18 stand rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicant has amended claim 5 to delete the recitation of the "Windows" trademark, and has further amended claims 10 and 15 to address the lack of antecedent basis problems noted by the Examiner. Applicant has also amended claim 17 to now recite an apparatus that is directed to the combination of a transaction aid and a computer to execute the transaction aid. Claim 18 has been amended to depend from claim 17. Applicant thus submits that all §112 claim rejections are now moot.

Rejection under 35 U.S.C §101

Claims 16, 19 and 20 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. These claims have been amended to address statutory subject matter, and Applicant submits that this rejection has therefore been overcome.

Rejection under 35 U.S.C §102

Claims 1-3 and 15-20 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,867,714 to Todd. In particular, the Examiner finds that, with regard to claim 1, Todd discloses all of the claimed limitations. Applicant has reviewed the reference with care, paying particular attention to the passages cited, and is compelled to respectfully disagree with the Examiner's characterization of this reference.

Claim 1 recites, *inter alia*, elaborating in a conformity server an ideal hardware configuration for a computer and comparing the ideal configuration to the actual configuration of the computer. Todd, on the other hand, is not concerned with elaborating an *ideal hardware* configuration, but rather with preventing *software conflicts*. The Examiner is relying mainly upon a brief passage in Todd (col. 12, ll. 30-57) that mentions that in addition to resolving conflicts, "promotional data" may also be presented to the user suggesting processor or memory upgrades, or replacing the entire computer system outright. Such suggestions may be based upon the amount of time the user spends using a particular software application. Applicant submits that this is most definitely not anticipatory of the claimed elaborating in a conformity server an ideal hardware configuration for a computer and comparing the ideal configuration to the actual configuration of the computer. Although it is possible that, with the benefit of hindsight and after having read Applicant's claims, the disclosure of Todd may be seen as somewhat related to the present invention, Applicant submits that the disclosure of Todd falls far short of rendering the present invention obvious to person skilled in the art, and even more so of outright anticipating the present invention. There is nothing in Todd that would urge a skilled person to consider analyzing the software installed in a computer, then elaborating an *ideal hardware* configuration for running all this software. At most, Todd can be understood as teaching the possibility of targeted *advertising*: "The remote data source 130 may further include *promotional* data. The promotional data is not used for solving problems that the user may have, but, instead, is directed to communicating *opportunities* to the user *in a targeted fashion*." (col. 12, ll. 30-34, emphasis added). There is simply nothing in Todd that even hints at the present invention's overarching goal of determining the ideal hardware configuration required to run a particular software package.

Todd also does not teach, in response to said comparison, transmitting information to the monitoring agent so that the latter can initiate a business transaction with an external server. Todd does remark, off-handedly, that the “remote data source 130 may also be employed in an automated ordering process, wherein the user can automatically order processor or memory upgrades, for example, without having to interact with sales personnel.” However, the remote data source has been likened by the Examiner to the presently claimed conformity server, and thus it cannot possibly be understood as teaching that the *monitoring agent*, which resides on the computer, can initiate a business transaction with an external server.

For the above reasons, Applicant submits that Todd does not in fact anticipate claim 1, and respectfully urges the Examiner to reconsider and pass this claim.

Claim 2 similarly recites the elaboration of an ideal hardware configuration, which as explained above, is not found in Todd. Furthermore, claim 2 also recites informing when necessary the user of the lack of hardware resources reported by the ideal configuration determination step. Todd does not inform the user of such a lack of resources, because Todd does not derive an ideal configuration for the user’s computer. As discussed, all Todd informs the user of are *promotional opportunities*, i.e. advertising. Applicant therefore respectfully submits that claim 2 is also novel and allowable over Todd.

Claims 3 and 15-20 depend directly or indirectly from claim 1. In view of the above discussion, it is submitted that claim 1 is allowable, and for this reason claims 3 and 15-20 are also allowable.

Rejection under 35 U.S.C §103

Claims 4-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of the DMTF paper, Revashetti and/or Kenner.

Claims 4-14 depend directly or indirectly from claim 1. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above

discussion of claim 1, Applicant submits that claims 4-14 are also allowable, and are therefore not individually addressed elsewhere herein.

Regarding the prior art made of record by the Examiner but not relied upon, Applicant believes that this art does not render the pending claims unpatentable.

In view of the above, Applicant submits that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

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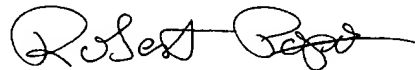


(Signature)

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(Date)

Respectfully submitted,



Robert Popa

Attorney for Applicants

Reg. No. 43,010

LADAS & PARRY

5670 Wilshire Boulevard, Suite 2100

Los Angeles, California 90036

(323) 934-2300 voice

(323) 934-0202 facsimile

rpopa@ladasparry.com